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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/728,374
Filing Date: December 04, 2003
Appellant(s): FRANK ET AL.

Faustino A Lichauco
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/16/2009 appealing from the Office action
mailed 10/31/2008

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5793365	Tang	1-1996
6360252	Rudy	8-2008
6895558	Loveland	2-2000
200400788443	Malik	10-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims **1-9, 11, 13-23, 25-28, 33, 89, 90** are rejected under 35 U.S.C. 103(a) as being anticipated over Tang et al (US Pat 5,793,365) hereafter known as Tang, in view of Loveland (US Pat 6895558).
2. Consider **Claim 1**, Tang et al clearly discloses a method comprising: receiving from a first person a request to converse with a second person using any one of two or more selectable communication modes (Tang et al, Fig 1A, Fig 1B, Col 5 Lines 55-67, Col 6 Lines 1-10 Col 15 Claim 1 and 2);
3. But Tang et al does not explicitly disclose the selection of the second mode being determined by a rule created by the second person and in response to the received request, automatically performing an action using a second one of the two or more communication modes.
4. Nonetheless, Loveland disclosed the selection of the second mode being determined by a rule created by the second person and in response to the received request (Loveland, Fig 5-6, Col 12 Lines 37-50, Loveland disclosed on how rules are being used for communication purposes), automatically performing an action using a second one of the two or more communication modes (Loveland, Col 12 Lines 54-59,

Loveland disclosed on how different communications can be chosen as stated by the rules).

5. Both Tang-Loveland provide features related to communication in the network with the use of rule management. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

6. Therefore, it would have been obvious to a person skilled in the art at the time of the invention was made to incorporate the use of rule management taught by Loveland, in the system of Tang for the purposes of management of different types of communication methods/preferences as stated by the user.

7. Consider **Claim 2**, Tang-Loveland disclosed a method of claim 1 wherein the rule is created by the second person using a user interface on a computing device (Loveland, Fig 5-6, Col 12 Lines 37-59, Loveland disclosed on how the rules are stated by the user).

8. Consider **Claim 3**, Tang-Loveland disclosed a method of claim 1 further comprising selecting the rule from a set of one or more rules based on a condition statement of the rule (Loveland, Fig 5-6, Col 12 Lines 37-50, Loveland disclosed on how the rules are chosen).

9. Claim 4 has similar limitations as Claim 3, therefore it is rejected under the same rationale as Claim 3.

10. Consider **Claim 5**, Tang-Loveland disclosed a method of claim 1 further comprising identity of the first person (Col 5 Lines 55-66, Col 6 Lines 1-10). Tang et al clearly shows the different states which can range from attentive, idle, engaged, do not disturb, and absent states to the identify of the first person (Col 5 Lines 55-66, Col 6 Lines 1-10). Loveland disclosed on the rules are selected/created in the system by the user (Loveland, Fig 5-6, Col 12 Lines 37-50)

11. Consider **Claim 6**, Tang-Loveland disclosed a method of claim 1 further comprising selecting the rule based on a current status of the second person (Col 6 Lines 29-36, Col 7 Lines 29-55). Tang et al clearly shows on how rules affect the status of the second person. Different types of icons are used to represent the various states of user's status (Col 6 Lines 29-36). But Loveland disclosed on how the rules are selected and created Loveland, (Loveland, Fig 5-6, Col 12 Lines 37-50).

12. Consider **Claim 7**, Tang-Loveland disclosed a method of claim 1 further comprising determining an electronic document associated with the first person and retrieving the electronic document if the second person indicates a desire to view the document (Tang, Col 9 Lines 42-50). Tang et al shows on how files and other data objects are transferred between users (Tang, Col 9 Lines 42-50).

13. Consider **Claim 8**, Tang-Loveland disclosed a method of claim 7 further comprising displaying the electronic document to the second person (Tang, Col 9 Lines

42-50, Col 10 Lines 33-36). Tang et al shows on how electronic documents are displayed between users (Col 9 Lines 42-50).

14. Consider **Claim 9**, Tang-Loveland disclosed a method of claim 7 further comprising retrieving the electronic document from an e-mail storage module, wherein the electronic document is an e-mail message (Tang, Col 8 Lines 6-10). Tang et al shows that one of the methods of communication can indeed be in a form of an email between users (Tang, Col 8 Lines 6-10).

15. Consider **Claim 11**, Tang-Loveland disclosed a method of claim 1 wherein automatically performing the action further comprises enabling the first person to leave a message if the current status of the second person is that the second person is unavailable to converse (Tang, Fig 1, Fig 2, Col 5 Lines 55-66, Col 6 Lines 1-10, Lines 27-37). Tang et al clearly shows on how first person receives the status of the second person, when the second person is unable to converse. Different types of icons are used to represent the various states of user's status (Tang, Col 6 Lines 29-36).

16. Consider **Claim 13**, Tang-Loveland disclosed a method of claim 1 wherein the one of two or more communication modes comprises a voice conversation communication mode (Tang, Fig 11 – Audio-Conference 83, Col 4 Lines 15-22, Col 13 Lines 9-11, Col 14 Lines 46-57). Tang et al does show that one of the types of communication modes can be in voice conversation mode with the use of microphone

and speakers (Tang, Fig 11 – Audio-Conference 83, Col 4 Lines 15-22, Col 13 Lines 9-11, Col 14 Lines 46-57).

17. Consider **Claim 14**, Tang-Loveland disclosed a method of claim 13 wherein the voice conversation communication mode comprises Voice over Internet Protocol (Tang, Fig 11 – Audio-Conference 83, Col 4 Lines 15-22, Col 13 Lines 9-11, Col 14 Lines 46-57). Tang et al clearly does show that one of the types of communication modes can be carried out with the use of VOIP.

18. Consider **Claim 15**, Tang-Loveland disclosed a method of claim 1 wherein the one of two or more communication modes comprises a voice/video conversation communication mode (Tang, Fig 11 – Audio-Conference 83, Video-Conference 81, Col 4 Lines 15-22, Col 13 Lines 9-11, Col 14 Lines 40-57). One of the types of communication can be carried out with the use of a web cam for voice/video conversation mode.

19. Consider **Claim 16**, Tang-Loveland disclosed a method of claim 1 wherein the one of two or more communication modes comprises a graphic text-based conversation communications mode (Tang, Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines 22-37). Tang et al clearly a show one of the types of communication is in the form of chat mode, which uses text-based conversation.

20. Consider **Claim 17**, Tang-Loveland a method of claim 16 wherein the graphic text-based conversation communication mode comprises Instant Messaging (Tang, Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines 22-37). Tang et al clearly a show one of the types of communication is in the form of chat mode, which uses text-based conversation, therefore instant messaging.

21. Consider **Claim 18**, Tang et al clearly discloses a system comprising: a computing device comprising: a transceiver configured to receive a request to converse with a user of the computing device; using a selected first one of two or more selectable communication modes; and an integration module configured to automatically perform an action using a second one of the two or more communication modes (Tang, Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2, Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines 22-37).

22. But Tang et al does not explicitly disclose the selection of the second mode being determined by a rule created by the second person and in response to the received request, automatically performing an action using a second one of the two or more communication modes.

23. Nonetheless, Loveland disclosed the selection of the second mode being determined by a rule created by the second person and in response to the received request (Loveland, Fig 5-6, Col 12 Lines 37-50, Loveland disclosed on how rules are being used for communication purposes), automatically performing an action using a second one of the two or more communication modes (Loveland, Col 12 Lines 54-59,

Loveland disclosed on how different communications can be chosen as stated by the rules).

24. Both Tang-Loveland provide features related to communication in the network with the use of rule management. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

25. Therefore, it would have been obvious to a person skilled in the art at the time of the invention was made to incorporate the use of rule management taught by Loveland, in the system of Tang for the purposes of management of different types of communication methods/preferences as stated by the user.

26. Consider **Claim 19**, Tang-Loveland disclosed the system of claim 18 wherein the integration module comprises a microphone and a speaker (Tang, Col 13 Lines 5-12, Col 7 Lines 3-8). The use of a microphone and a speaker is clearly shown.

27. Consider **Claim 20**, Tang-Loveland the system of claim 18 wherein the integration module comprises a user interface hook to detect when the user is interacting with the computing device (Tang, Col 15 Lines 13-22). The use of the activity manager detects when the user is interacting with the computing device.

28. Consider **Claim 21**, Tang-Loveland disclosed the system of claim 18 wherein the integration module comprises a user interface that enables the user to specify the action

(Tang, Col 7 Lines 65-67, Col 8 Lines 1-14). Tang et al clearly shows on what type of action involving communicating with other users can be carried out.

29. Consider **Claim 22**, Tang-Loveland disclosed the system of claim 18 further comprising a network (Tang, Col 11 Lines 37-40). Various types of networks can be used.

30. Consider **Claim 23**, Tang-Loveland disclosed the system of claim 22 further comprising a second computing device configured to send the request to converse (Tang, Col 11 Lines 66-67, Col 12 Lines 1-8). Tang et al shows that a second computing device is required to send the request to converse with the users on the network.

31. Consider **Claim 25**, Tang-Loveland the system of claim 22 further comprising a switched local area network (Tang, Col 11 Lines 37-40). Various types of network can be used to communicate with the users.

32. Consider **Claim 26**, Tang-Loveland disclosed the system of claim 25 wherein the transceiver is further configured to receive a request to converse via the switched local area network (Tang, Col 13 Lines 5-12, Col 7 Lines 3-8, Col 11 Lines 37-40). Tang et al clearly shows that the transceiver can be comprised of speakers and microphone attached to the computing device.

33. Consider **Claim 27**, Tang-Loveland disclosed the system of claim 25 wherein the switched local area network is configured to connect the computing device to an Internet (Tang, Col 11 Lines 37-40). Various types of network can be used.

34. Consider **Claim 28**, Tang-Loveland disclosed the system of claim 25 wherein the switched local area network is configured to connect the computing device to an intranet (Tang, Col 11 Lines 37-40). It is inherent to use Intranet in a network that can easily be part of a LAN.

35. Consider **Claim 33**, Tang et al clearly discloses an article comprising a machine-readable medium that stores executable instruction signals that cause a machine to: receive, from a first person, a request to converse with a second person using a selected first one of two or more selectable communication modes (Tang, Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2) Tang et al clearly shows the method of a first person request to converse with second person in the figures (Fig 1A, Fig 1B). And Tang et al also shows the states which can range from attentive, idle, engaged, do not disturb, and absent states (Col 5 Lines 55-66, Col 6 Lines 1-10).

36. But Tang et al does not explicitly disclose the selection of the second mode being determined by a rule created by the second person and in response to the received

request, automatically performing an action using a second one of the two or more communication modes.

37. Nonetheless, Loveland disclosed the selection of the second mode being determined by a rule created by the second person and in response to the received request (Loveland, Fig 5-6, Col 12 Lines 37-50, Loveland disclosed on how rules are being used for communication purposes), automatically performing an action using a second one of the two or more communication modes (Loveland, Col 12 Lines 54-59, Loveland disclosed on how different communications can be chosen as stated by the rules).

38. Both Tang-Loveland provide features related to communication in the network with the use of rule management. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

39. Therefore, it would have been obvious to a person skilled in the art at the time of the invention was made to incorporate the use of rule management taught by Loveland, in the system of Tang for the purposes of management of different types of communication methods/preferences as stated by the user.

40. Consider **Claim 89**, Tang et al clearly shows the following system comprising: a computer device; a user interface that is configured to enable a user to interact with a person using one of at least two of voice conversation (Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2), voice-video conversation (Fig 11 – Audio-Conference 83, Video-Conference 81, Col 4 Lines 15-22, Col 13 Lines 9-11, Col 14 Lines 40-57), graphic text-based

conversation (Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines 22-37), fax, and electronic mail (Col 8 Lines 6-10); displaying to the user an automatically generated listing of a set of persons, the listing comprising a name, presence information, and communication modes available for the user to communicate with the person from the set of persons (Col 5 Lines 55-66, Col 6 Lines 1-10).; receiving an instruction to select the person from the set of persons (Col 5 Lines 55-66, Col 6 Lines 1-10); retrieving information about a person using an identifying characteristic of the person, where the identifying characteristic is selected by the user from a display (Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2).

41. But Tang et al does not explicitly disclose the wherein the interaction comprises: creating a rule to cause the computer device to automatically perform an action based on a request to converse with the user, and using the rule to select a communication mode from the communication modes available to communicate with the person, and using the rule to establish communication between the user and the person.

42. Nonetheless, Loveland disclosed the wherein the interaction comprises: creating a rule to cause the computer device to automatically perform an action based on a request to converse with the user (Loveland, Fig 5-6, Col 12 Lines 37-50, Loveland disclosed on how rules are being used for communication purposes), and using the rule to select a communication mode from the communication modes available to communicate with the person (Loveland, Fig 5-6, Col 12 Lines 37-59, Loveland disclosed on how rules are being used for communication purposes), and using the rule

to establish communication between the user and the person (Loveland, Fig 5-6, Col 12 Lines 37-50)

43. Both Tang-Loveland provide features related to communication in the network with the use of rule management. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

44. Therefore, it would have been obvious to a person skilled in the art at the time of the invention was made to incorporate the use of rule management taught by Loveland, in the system of Tang for the purposes of management of different types of communication methods/preferences as stated by the user.

45. Consider **Claim 90**, Tang-Loveland disclosed the system of claim 18 in which the integration module is also configured to interact with the two or more communication modes, the modes including at least two of voice conversation software, voice-video conversation software, graphic text-based conversation software, fax software, and electronic mail software (Tang Fig 1A, Fig 1B, Col 15-16 Claim 1 and 2, Fig 5 – Chat window, Col 4 Lines 15-22, Col 9 Lines 22-37). Tang et al clearly shows the system capable of carrying out different types of communication methods.

46. **Claims 10, 24, 29-32** rejected under 35 U.S.C. 103(a) as being unpatentable over Tang et al (US Pat 5,793,365) in view of Loveland (US Pat 6,895,558), and further in view of Rudy et al (US Pat 6,360,252).

47. Consider **Claim 10**, Tang-Loveland does not explicitly disclose the method of claim 7 further comprising retrieving a calendar of the second person from a calendar storage module, wherein the electronic document is the calendar.

48. But nonetheless, Rudy et al clearly discloses the method of claim 7 further comprising retrieving a calendar of the second person from a calendar storage module, wherein the electronic document is the calendar (Rudy et al, Col 17, Lines 10-25).

49. Both Tang-Loveland-Rudy provide features related to different types of communication methods in the network. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

50. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a calendar taught by Rudy et al in Tang-Loveland method for calendar retrieval, for the purpose of allowing users on the network to make their schedules available for other users on the network to schedule appointments with them.

51. Consider **Claim 24**, Tang-Loveland does not explicitly disclose the system of claim 22 further comprising a telephone configured to send the request to converse.

52. Nonetheless, Rudy et al clearly discloses the system of claim 22 further comprising of a telephone configured to send the request to converse (Rudy et al, Col 26 Lines 20-24).

53. Both Tang-Loveland-Rudy provide features related to communication methods in the network. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment

54. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a telephone to send the request to converse in the application taught by Rudy et al in Tang et al's system, for the purpose of allowing users communicate via analog land telephone lines with each other.

55. Consider **Claim 29**, Tang-Loveland does not explicitly disclose wherein the switched local area network is configured to connect to an Internet protocol/public switched telephone network gateway.

56. Nonetheless, Rudy et al clearly discloses the switched local area network is configured to connect to an Internet protocol/public switched telephone network gateway (Rudy et al, Col 26 Lines 20-24).

57. Both Tang-Loveland-Rudy provide features related to communication methods in the network. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

58. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a switched telephone network

gateway to the LAN taught by Rudy et al in Tang-Loveland system, for the purpose of allowing users of the company to connect to the corporate network via the public telephone network gateway.

59. Consider **Claim 30**, Tang-Loveland-Rudy discloses the system of claim 29 wherein the network further comprises a second switched local area network (Tang, Col 11 Lines 37-40). Various types of network can be used to communicate with the users.

60. Consider **Claim 31**, Tang-Loveland-Rudy disclosed the system of claim 29, wherein the second computing device sends the request to converse via the second switched local area network (Tang, Col 11 Lines 66-67, Col 12 Lines 1-8). Tang et al shows that a second computing device is required to send the request to converse with the users on the network which can be on the second switched local area network.

61. Consider **Claim 32**, Tang-Loveland do not explicitly disclose the system of claim 31 wherein the network further comprises a telephone system and a public switched telephone network configured to enable the telephone to send the request to converse to the computing device.

62. Nonetheless Rudy et al clearly discloses the system further comprises a telephone system and a public switched telephone network configured to enable the telephone to send the request to converse to the computing device (Rudy et al, Col 26 Lines 20-24).

63. Both Tang-Loveland-Rudy provide features related to communication methods in the network. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

64. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a telephone to send the request to converse in the application taught by Rudy et al in Tang-Loveland's system, for the purpose of allowing users of the company to connect to the corporate network via the public telephone network with aid of a telephone/fax modem.

65. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tang et al (US Pat 5,793,365) in view of Loveland (US Pat 6895558), and further in view of Malik (US Pub 2004/0078443).

66. Consider **Claim 12**, Tang-Loveland does not explicitly disclose the method of claim 1 wherein automatically performing the action further comprises forwarding the request to converse to a third person if a current status of the second person is that the second person is unavailable to converse and the third person is available to converse

67. Nonetheless, Malik discloses automatically performing the action further comprises forwarding the request to converse to a third person if a current status of the second person is that the second person is unavailable to converse and the third person is available to converse (Malik, [0075]-[0079]). Malik discloses transferring of messages to third party.

68. Both Tang-Loveland-Malik provide features related to communication methods in the network relating to users. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

69. Therefore it would have been obvious to a person skilled in the art at the time of the invention was made to incorporate transferring of communication request to third party, taught by Malik in the system of Tang-Loveland, for the purpose of ensuring communication is carried out even if one of the member of the party is unavailable to converse.

(10) Response to Argument

The examiner summarizes the various points raised by the Appellant and addresses replies individually.

As per Appellant's argument that:

Argument (1) Appellant asserts that the combination Tang-Loveland fails to teach the selection of communication mode determined by a rule created by a "second person". And Loveland fails to teach "in response to the received request, automatically performing an action using a second one...of the communication modes;" and the appellant does not agree with the motivation to combine Loveland with Tang.

Appellant further asserts that in Loveland the selection of communication is done by the IMR system's rule engine and is not determined by a rule created by "the second

person" (i.e., the person with whom the first person would like to communicate).

Appellant states that in Loveland, the IMR system's rules engine that "formulates a response" to a received communication, with part of that response formulation including selection of a communication mode by the rules engine. Therefore, instead of teaching claim 1 limitation that "selection of the second mode [of communication]" is "determined by a rule created by the second person," Loveland teaches that the IMR system's rules engine, not a person, determines how to establish communication between two people. The rules engine does so by accessing various parameters, some of which are user-defined and some of which are automatically defined by the IMR system. However, Loveland's mere accessing of user-defined parameters does not result in "a rule created by the second person," because Loveland's IMR system, and not "the second person," is determining the mode of communication that is established between a first and second person. For example, the rules engine employs various "user-defined options" in formulating the response. However, these user-defined options only specify the "type of response" (e.g., leaving a message) or a user's state (e.g., "on the phone" or "in a meeting") and thus fail to produce "a rule created by a person." Appellant states that in Loveland the "response options" actually refer to a type of response, independent of the mode used in communicating the response. Appellant states that the response type does not specify a communication mode and therefore Loveland's "type of response" is not a "selection of the second mode of communication", that is "determined by a rule created by the second person". Appellant further points out that *Loveland's* "response options," the "user state" fails to produce "a rule created by the second person" to

"select [a] mode [of communication]." In fact, the "user state" fails to select any mode of communication at all. Moreover, the "user state" is only one of many parameters applied by the rules engine in formulating a response, none of which are "user-defined parameters". In essence Appellant argues that Loveland fails to teach that "selection of the second mode [of communication]" is "determined by a rule created by the second person".

In reply to Argument (1), in response to Appellant's argument that the reference fails to disclose "selection of the second mode [of communication]" is "determined by a rule created by the second person". Loveland clearly discloses that the communication rule is created by the second person and not only by the IMR system. Loveland clearly discloses that the IMR system which controls the rules is configured by a user (Loveland, Col 4 Line 1-5). As such the system is configured by the user, then the rule engine which attempts to establish communication between two users are indeed configured by the user (Loveland, Col 12 Lines 35-60). Therefore Loveland disclosed the selection of the second mode being determined by a rule created by the second person and in response to the received request (Loveland, Fig 5-6, Col 12 Lines 37-50, Loveland disclosed on how rules are being used for communication purposes), automatically performing an action using a second one of the two or more communication modes (Loveland, Col 12 Lines 54-59, Loveland disclosed on how different communications can be chosen as stated by the rules). Loveland clearly discloses that the rules are manually created by the user (Loveland, Col 4 Line 1).

And Applicant does not agree with the motivation to combine Loveland with Tang. Examiner states that the motivation to combine Loveland with Tang is valid as Tang does not explicitly teach the communication rule is configured by the user, but Loveland does indeed disclose that the communication rule is taught by the user (Loveland, Col 4 Lines 1-5). The reference Loveland is brought in to overcome the deficiencies which were present in Tang. And both the references are within the same environment. Therefore it would have been obvious to a person skilled in the art to combine the two references.

Argument (2) Appellant argues that the combination of Tang-Loveland teach away from the invention as Loveland fails to teach “automatically performing an action using a second one of the two or more communication modes, selection of the second mode being determined by a rule created by the second person”.

In Reply to Argument (2) But Loveland does not teach away from the invention, as Loveland disclosed on how different communications can be chosen as stated by the rules). Loveland clearly discloses that the rules are manually created by the user (Loveland, Col 4 Line 1-5). And Tang et al clearly discloses a method comprising: receiving from a first person a request to converse with a second person using any one of two or more selectable communication modes (Tang et al, Fig 1A, Fig 1B, Col 5 Lines 55-67, Col 6 Lines 1-10 Col 15 Claim 1 and 2, Col 8 Lines 8-10) in Tang one can see in Fig 1A and 1B that there are types of communication modes available from phone, email or chat etc. The combination of Tang-Loveland does teach the invention of the appellant as the appellant's invention states the use of rules created by the user to

determine which selectable communication modes to use between the users. And since Loveland teaches that the rules can be created by the user, and Tang discloses the different communication modes, it would then be obvious to person skilled in the art to combine the teachings of Tang-Loveland to create a system in which communication modes are selected by the rules created by the second person.

Argument (3) Applicant argues that rejections for claims 10, 24 and 29-32 are invalid as the Examiner has failed to articulate "with some rational underpinning" any reason to combine Loveland, Tang and Rudy.

In Reply to Argument (3) - Claim 10 is rejected under the combination of Tang-Loveland-Rudy because Rudy discloses on how calendar information is retrieved (Rudy, Col 17 Lines 10-25). And since the claim states it is about retrieving calendar information, the limitation by incorporating Tang-Loveland does not satisfy it clearly until Rudy is presented in combination to clearly state on the retrieval of calendar information. It is obvious to a person skilled in the art to incorporate the use of a calendar to obtain information. The reference Rudy was brought in to further strengthen and clarify the obvious rejection provided by Tang-Loveland (See KSR Decision- MPEP 2143).

Claim 29 is rejected under the combination of Tang-Loveland-Rudy because Rudy disclosed the limitation of "the switched local area network" being "configured to an internet protocol/public switched telephone network gateway. The motivation to use

Rudy with combination of Tang-Loveland is to clarify that the client machines (or user systems) can be run on remote or mobile devices such as cellular telephones, pages, landline display screen telephones, set-top boxes, general purpose computers. It is common in the art to see that landline screen telephones are run on a public switched telephone network gateway and since communication are carried out with pc's, and use of Internet (Rudy, Col 28, Lines 49-60). It is common in the art to see that the use of Internet is carried with the aid of the internet protocol. It is obvious to a person skilled in the art to incorporate the use of switched local area network. The reference Rudy was brought in to further strengthen and clarify the obvious rejection provided by Tang-Loveland (See KSR Decision- MPEP 2143).

Argument (4) Applicant argues that rejections for claims 12 are invalid as the combination of Tang-Loveland-Malik has failed to teach "automatically performing the action...[if] the third person is available to converse"

Claim 12 recites the additional limitation of:

Automatically performing the action further comprises forwarding the request to converse to a third person if a current status of the second person is that the second person is unavailable to converse and the third person is available to converse

The Appellant argues that Malik fails to teach the limitations of claim 12, because claim 12's performance of the action is contingent on two conditions: (a) a current status of the second person is that the second person is unavailable to converse and (b) the third person is available to converse. Malik's messages are "auto-forwarded" and "auto-

transferred," without any checking whatsoever as to the availability of "Romeo" or "Mercutio." Therefore, Malik fails to teach claim 12's limitations of checking the status of the second person and the third person. As a result, Malik does not disclose the subject matter missing from Tang's disclosure.

In reply to Argument (4) the Examiner states that the combination of Tang-Loveland-Malik is valid as firstly Tang disclosed the medium in which users can communicate with the other users (Tang et al, Fig 1A, Fig 1B, Col 5 Lines 55-67, Col 6 Lines 1-10 Col 15 Claim 1 and 2, Col 8 Lines 8-10). And Loveland discloses the rule engine which can be configured by the user in order to be able to create custom communication methods which are presented to the users by the system. And Malik clearly discloses (a) current status of the second person is that the second person is unavailable to converse (Malik, discloses that communication is between three users for example - Romeo, Juliet and Mercutio - Malik [0073].) And Malik discloses that the Romeo's presence is conveyed to Romeo's entire contact list and Romeo's contact list can have many users. Malik in [0075] discloses on how the messages can be transferred to another IM addresses and Malik discloses on how the system checks to see the indicator message indicating that the current user is away (Malik, [0076] - Malik states that the user is currently unavailable) and the third person is available to converse with the user (Malik in [0075]-[0077]). Malik discloses on how the message from Juliet to Romeo can be auto-transferred to Mercutio, thus indicating the use of the third party. Therefore Malik does indeed disclose to check the availability of the users and the use of transferring of messages to other users.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/AS/

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